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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,733	12/09/2003	Gregory J. Ward	14-54(14054)01	5174

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EXAMINER

DAVIS, BRIAN J

ART UNIT PAPER NUMBER

1621

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/731,733

Applicant(s)

WARD ET AL.

Examiner

Brian J. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/16/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The examiner states for the record that the C3 reference on the IDS was lined-through inadvertently. Although applicant has apparently not supplied the reference in the instant application, it is available and of record in the parent application. The reference has been considered and is listed on a PTO-form 892.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: the claim text ends with a comma. Claims must begin with a capital letter and end with a period. MPEP 608.01(m). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112, FIRST PARAGRAPH***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 13 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a sponge-type hydrogenation catalyst, does not reasonably provide enablement for the *universe* of all possible catalysts. The specification does not enable any person skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

With regard to rejections under 35 USC 112, first paragraph, the following factors are considered (*In re Wands* 8 USPQ 2d 1400, 1404 (CAFC 1988)): a) Breadth of claims; b) Nature of invention; c) State of the prior art; d) Level of ordinary skill in the art; e) Level of predictability in the art; f) Amount of direction and guidance provided by the inventor; g) Working examples and; h) Level of experimentation needed to make or use the invention based on the content of the disclosure.

a)The claims are quite broad with respect to the catalyst: "a catalyst." That is, the *universe* of all *possible* catalysts.

b,c)The nature of the invention is determined in part by the state of the prior art. The prior art in general teaches processes related to that of the instant invention under very specific reaction conditions. That is, starting materials, products, solvents, catalysts, temperature ranges, pressure ranges, reactors etc. are explicitly defined.

d)The level of skill in the art is considered to be relatively high.

e)The level of predictability in the art is considered to be relatively low. Even under the best of circumstances, and several hundred years after Lavoisier laid the foundations of its modern practice, chemistry remains an experimental science. This is especially so with regard to the catalytic chemical arts; catalyzed reactions, e.g. hydrogenations, being notoriously sensitive to changes in catalyst composition, type, form, pretreatment, etc.

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f,g)The amount of direction provided by the inventor is considered to be determined by the specification and the working examples. Applicant's working examples are drawn exclusively to sponge nickel catalysts.

h)It is not possible to make and use the instant invention without an undue level of experimentation. The specification must teach how to make and use the invention, not how to figure out for oneself how to make and use the invention. *In re Gardner*, 166 USPQ 138 (CCPA 1970). Applicant's narrow working examples using sponge nickel catalysts in the instant hydrogenation cannot reasonably be extrapolated to encompass the use of the *universe* of all possible catalysts in such hydrogenations.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13 and 15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,869,653, cited by the applicant in the IDS.

The reference teaches the hydrogenation of 3-dimethylaminopropionitrile (N,N-dimethylaminopropionitrile) using a sponge cobalt catalyst in the presence of lithium hydroxide and water. Initial pressurization and temperature are at 75 psig and 100°C, respectively.

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The examiner notes for clarity of the record that applicant's use of "open language" (...*comprising*...) in the formulation of the instant claims encompasses the teaching of the prior art, even though the prior art also teaches that the pressure is raised to 850 psig after the reaction has reached 100°C.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,660,887 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other. The limitations of the claim sets in the instant application and the patent are grouped in slightly different ways, however, they are essentially identical. The only difference with respect to limitations, irrespective of grouping, is that the patent contains a limitation that the reaction medium be thoroughly mixed (e.g. column

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10 line 56). However, this limitation is intrinsic and may be thought of as a mere engineering expediency.

Additionally, applicant is advised that should claim 10 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 5,898,085 is cited to show a related process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
January 22, 2005